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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,538	12/21/1999	HIDEKAZU SAKAI	0649-0710P-S	3756

7590

12/13/2001

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EXAMINER
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WALKE, AMANDA C

ART UNIT	PAPER NUMBER
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1752

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DATE MAILED: 12/13/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/468,538

Applicant(s)

SAKAI ET AL.

Examiner

Amanda C Walke

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-9 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-9 and 11-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

#### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/7/2001 has been entered.

#### *Specification*

2. The abstract of the disclosure is objected to because it is longer than 150 words. Correction is required. See MPEP § 608.01(b).

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 4, 6-8, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al (5,273,866) in view of Sakai (5,573,898).

Fujita et al disclose a silver halide photographic material comprising a support having coated thereon at least one blue, green, and red emulsion layer, and one or more hydrophilic colloid layers containing a dispersion of microcrystals of at least one compound represented by formulas I-VI which results in improved sharpness and preservability. Dyes I-IV are of structure similar to the present formulas I-III, IV, and XI. The dyes may contain cyano groups

Art Unit: 1752

in the R2 and R5 positions (see III-27, 32), and hydrogen substituents in the R3 and R6 positions (III-34). These dyes are incorporated as a dispersion of finely divided solid into a layer of the emulsion such as a hydrophilic colloid layer to be coated onto a photographic element. The photographic material of example 1 comprises a support having coated thereon a non-coloring light-insensitive antihalation layer between the support and the light sensitive emulsion layer (column 59). The material may be used for motion pictures (column 54, lines 11-16). The dispersion can be prepared by precipitating a dye in the form of a dispersion and/ or by subjecting a dye to fine grinding by a known means such as ball mill in the presence of a dispersant or dissolve the dye in a solvent optionally adding a surface active agent. Also, as shown in Table 3, the material is treated at 40 degrees C after chemical sensitization. The dye grains should have a mean diameter of 10 micrometers or less but preferably 0.5 micrometers or less (column 35 lines 37-68). This overlaps with the range in the present claim 6. The dye appears to be added in an amount meeting the limitations of the present claim 8 (column 36, lines 38-41). These dyes may partially or completely replace colloidal silver usually present in filter or antihalation layers. The pH of the <sup>emulsion</sup> materials in the examples of the reference is 6.2 which is ~~within the scope of the present claim limitations.~~

Sakai teaches the use a pyrrolotriazole coupler, specifically a cyan coupler, which is of structure similar to the present formula (1) in a color photographic material. These couplers are known to provide excellent color hue (column 2, lines 5-10). Position X of the reference formula (Ib) is any group capable of splitting off from the compound by the coupling reaction with an oxidation product of an aromatic primary amine color developing agent ( see column 15). Position X of the formula (Ib) of the reference is the position in the present formula (1)

Art Unit: 1752

where the  $-O_2C-X$  substituent resides. Exemplified coupler 41 contains a  $-O_2C-X$  substituent in the present position X, which in the reference is a group which links the nitrogen of a nitrogen-containing heterocyclic group to the coupling position. The reference exemplifies substituents in the present positions R1 and R2 which meet the present limitations for the p value (see couplers 9, 14, 31, 35, 36, and 39-42). The grains of the reference are preferably high silver chloride grains having a chloride content of 98-100 mol % (column 61, line 56- column 62, line 19). heterocyclic group to the coupling position. Sakai teaches that pyrazoloazole couplers are better than phenol or naphthol couplers because there is less unfavorable absorption of the dyes formed by the pyrazoloazole couplers than by those formed by the conventional cyan couplers (column 1, line 16 - column 2, line 11).

Sakai teaches that pyrazoloazole couplers are better than phenol or naphthol couplers because there is less unfavorable absorption of the dyes formed by the pyrazoloazole couplers than by those formed by the conventional cyan couplers (column 1, line 16 - column 2, line 11), therefore it would have been obvious to one of ordinary skill in the art to prepare the motion picture film of Fujita et al in view of Sakai choosing to replace the phenol or naphthol couplers of Fujita et al with a pyrazoloazole coupler of Sakai to achieve improved color reproduction.

5. Claims 12-17, 19, 20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al in view of Ohshima et al (5,391,471).

Fujita et al has been discussed above. The reference discloses the preferred pH of the silver halide emulsion, but fails to disclose the preferred pH of the film material.

Art Unit: 1752

Ohshima et al disclose a silver halide photographic material comprising a support, a non-light sensitive hydrophilic colloid layer coated on the support, and a silver halide emulsion layer. The reference teaches that it is preferable for the pH of the film material (the pH value of all of the constituent layers obtained by the coating the coating solution on the support) be between 5.0 and 6.5 which falls within the presently claimed range. If the pH of a silver halide material falls below 5.0, it causes a disadvantage in that the film hardening is lowered or the sensitivity is lowered. If the pH of a silver halide material exceeds 6.5, it leads to desensitization upon exposure under conditions of high humidity or sensitivity fluctuation with the change of the time interval between the completion of exposure and the beginning of processing (column 42, line 50-column 43, line 12).

With respect to the optical density, the optical density of a photographic material is a functional limitation. It is the position of the examiner that since the material of Fujita meets the physical limitations of the present claim 23, the material would also inherently meet the limitation of the present claim 15 for the optical density of the material.

Given the teachings of Ohshima et al, it would have been obvious to one of ordinary skill in the art to prepare the material of Fujita et al choosing to adjust the pH of the final film material to be from 5.0 to 6.5 to prevent a decrease in sensitivity or film hardening with reasonable expectation of achieving a material having excellent sharpness and preservability.

6. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al (or Fujita et al in view of Sakai), in view of Swank et al (4,006,025).

M.P.E.P. § 2113:

“Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)... “The Patent Office bears a lesser burden proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. *In re Fessman*, 180 USPQ 324, 326 (CCPA 1974). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

Sakai, and Fujita et al have been discussed above.

Swank et al disclose a method for preparing finely divided dispersions of dyes. The process includes heating an organic solvent to dissolve the dye then dispersing the dye droplets, possibly with the help of a surfactant, in a suitable binder. The method includes a heat treatment step in which the temperature is between 40 and 50° C ( column 4, lines 17-36). Performing the milling step at an elevated temperature aides in dissolving the dye and results in a dispersion having finely divided dye crystals ( column 2, lines 3-16).

Fujita et al states that the dispersion can be prepared by precipitating a dye in the form of a dispersion and/ or by subjecting a dye to fine grinding by a known means such as ball mill in

Art Unit: 1752

the presence of a dispersant or dissolve the dye in a solvent optionally adding a surface active agent, therefore it would have been obvious to one of ordinary skill in the art to prepare the material of Fujita et al or Fujita et al in view of Sakai, choosing to use the method of preparing a dye dispersion taught by Swank et al with reasonable expectation of achieving a film protected from the generation of static charge after the carbon black-containing layer is removed.

6. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al or Fujita et al in view of Sakai, and Mifune et al (4,713,321).

Sakai and Fujita et al have been discussed above, but fail to teach the use of the specific surface active agents.

Mifune et al disclose examples of surface active agents which include alkylene oxide derivatives, and glycidol derivatives.

Fujita et al states that the dispersion can be prepared by precipitating a dye in the form of a dispersion and/ or by subjecting a dye to fine grinding by a known means such as ball mill in the presence of a dispersant or dissolve the dye in a solvent optionally adding a surface active agent, therefore it would have been obvious to one of ordinary skill in the art to prepare the material of Fujita et al or Fujita et al in view of Sakai choosing to use the a surface active agent such as polyalkylene oxide as taught by Mifune et al with reasonable expectation of achieving a photographic material having excellent sharpness and preservability.

#### ***Response to Arguments***

7. Applicant's arguments filed 11/7/2001 have been fully considered but they are not persuasive.



Art Unit: 1752

Firstly, applicant has argued that the Fujita et al reference does not teach the presently claimed pH of the film material. In response, the rejection of claims 11-20, 23, and 24 made in the previous office action have been dropped and the claims have been newly rejected.

The declaration filed 11/7/2001 (which is unsigned) has been considered, but is not commensurate in scope with the present claim limitations. The Examples of the declaration have not compared to the prior art of record. The samples used in the declaration employ a dispersing aid (claimed by dependent claim 5) and a preferred coupler of the present invention (the cyan coupler has a preferred "X" group).

Additionally, it is the position of the examiner that when one of ordinary skill in the art would prepare the material of Fujita et al in view of Sakai, the expected result would be a material having increased sharpness due to decreased bleeding of the couplers, which Sakai teaches as the advantage of using pyrazoloazole couplers rather than phenol or naphthol couplers because there is less unfavorable absorption of the dyes formed by the pyrazoloazole couplers than by those formed by the conventional cyan couplers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda C Walke whose telephone number is 703-305-0407. The examiner can normally be reached on M-R 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-872-9792 for After Final communications.

Art Unit: 1752


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



ACW

December 11, 2001

Amanda C Walke  
Examiner  
Art Unit 1752



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